

REMARKS

I. Status of the Application

Claims 1-28 are currently pending in the application. Claims 11-16 are withdrawn pursuant to a restriction requirement. Claims 21-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 19 stands rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,159,728 to Bingold. Claims 1, 2, 9, 10 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bingold in view of US Patent No. 1,797,539 to Arthur. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,469,813 to Peden in view of US Patent No. 5,193,254 to Geisinger. Claims 1-8, 18 and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peden in view of Arthur and Geisinger. Claims 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bingold in view of Arthur and Peden.

Applicant has amended the claims to more clearly define and distinctly claim Applicant's invention. Specifically, claim 21 has been amended to consistently recite a "semi-rigid" strap. Claim 19 has been amended to recite straps having at least three concentric coiled loops. Support for this amendment can be found in the specification at page 4, lines 4-5. Claim 9 has been amended to correct a formal matter. Applicant submits that the claim amendments add no new matter.

Applicant respectfully request entry and consideration of the foregoing amendments and consideration of the following remarks, which are intended to place this application in condition for allowance.

II. Claims 21-23 are Definite

At page 2, paragraph 4 of the instant Office Action, claims 21-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 21 as suggested by the Examiner to consistently recite a “semi-rigid” strap. Thus, independent claim 21 and its dependent claims 22 and 23 are definite. Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of claims 21-23.

III. Claim 19 is Novel over Bingold

At page 3, paragraph 1 of the instant Office Action, claim 19 stands rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,159,728 to Bingold. The Examiner is of the opinion that Bingold teaches each and every claim limitation. Applicant respectfully traverses the rejection based on the amended claim.

Amended claim 19 is directed to a disposable handcuff comprising two tightly coiled semi-rigid toothed straps having at least three concentric coiled loops, and a two slot, toothed socket clasp at about the midpoint of said straps. The disposable restraint of Bingold does not have at least three concentric coiled loops. Bingold only discloses two sets of two concentric loops (figure 1, “four-loop configuration” at col. 3, lines 37-48, col. 9, lines 40-51). Therefore, Bingold fails to teach each and every limitation of claim 19. Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of claim 19.

IV. Claims 1, 2, 9, 10 and 20 are Not Obvious over Bingold in view of Arthur

At page 3, paragraph 4 of the instant Office Action, claims 1, 2, 9, 10 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,159,728 to Bingold in view of US 1,797,539 to Arthur. The Examiner is of the opinion that it would be obvious to combine the curled restraint of Bingold with the elastic band of Arthur to arrive at the claimed invention. Applicant respectfully traverses the rejection. A *prima facie* case of obviousness requires three showings:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Manual of Patent Examining Procedure, 8th ed., § 2142. These requirements of a *prima facie* case of obviousness are not met for all of the following rejections under 35 U.S.C. § 103(a).

Applicant's invention is directed to a method of forming a compact disposable police restraint comprising the steps of selecting a cuff device comprising at least one (or two) elongated, substantially flat semi-rigid strap(s), connected to a toothed socket clasp, rolling the flat strap(s) of the cuff device into a coil, and securing the coil(s) with a plastic banding device. Applicant's invention is also directed to the restraint formed by said method, and further comprises the plastic banding device that holds the coil(s) in place.

While Bingold's device could be made into a compact form using Applicant's method, Bingold does not provide any motivation or suggestion to modify his four-loop

restraint configuration (figure 1, col. 3, lines 37-48, col. 9, lines 40-51) into a more compact form, nor does the patent teach or suggest that such a compact device could or should be secured in that compact form with a band. As shown in figure 1, the loops of Bingold's restraint are secured by friction of the ratchet portions 14 and 16 and the toothed surfaces of tip pulls 29 and 30 against the inner sides of apertures 51 and 52. Thus, Bingold's restraint does not need an elastic band to prevent its four-loop configuration from unwinding. Bingold makes no suggestion of the desirability to additionally secure the four-loop configuration with an elastic band.

Even if Bingold did suggest the desirability to additionally secure his four-loop restraint configuration, one skilled in the art of restraints would not reasonably be expected or motivated to look at photographic film retainers, such as those disclosed by Arthur. Arthur is clearly non-analogous art. Arthur in no way suggests that his disclosed elastic retainer may be used to prevent the unwinding of anything other than photographic film, and certainly not police restraints.

The mere fact that the prior art **may be modified** in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ 1780, 1783-84, n.14 (Fed Cir. 1992). One skilled in the art would not be led by either Bingold or Arthur to combine their respective teachings to produce the claimed invention. The Examiner cannot use hindsight reconstruction based on Applicant's disclosure to provide motivation to combine the references. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed Cir. 1983) *cert. denied*, 469 U.S. 851 (1984). As a *prima facie* case of obviousness has not been established, Applicant respectfully requests withdrawal of the rejection and allowance of independent claim 1 with dependent claims 2, 9 and 10, and independent claim 20.

V. Claim 17 is Not Obvious over Peden in view of Geisinger

At page 4, paragraph 2 of the instant Office Action, claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,469,813 to Peden in view of US 5,193,254 to Geisinger. The Examiner is of the opinion that it is obvious to combine the tightly coiled ankle restraint of Peden with the toothed, single slotted wrist or ankle restraint of Geisinger to arrive at the claimed invention. Applicant respectfully traverses the rejection.

One embodiment of Applicant's invention is directed to a disposable handcuff comprising a single tightly coiled semi-rigid toothed strap with a single slot, toothed socket clasp at one end thereof. Peden teaches tight coiling for storage of a flexible strap leg restraint preferably formed of nylon fabric belting material (col. 2, lines 3-16). However, Peden in no way suggests the desirability of using a semi-rigid material for the strap, nor does Peden suggest adding teeth and a single slot, toothed socket clasp at one end to secure the strap on a prisoner. Peden solves the problem of securing the strap on a prisoner using loops and rings, and does not motivate the skilled artisan to seek out another method. Also, Peden does not suggest using the disclosed ankle restraint as handcuffs.

Geisinger teaches a self-cinching wrist or ankle restraint with a toothed, single slotted strap. The Examiner asserts as motivation to combine references that Geisinger suggests that it is desirable to only restrain the hands so the prisoner can walk. On the contrary, Geisinger, similarly to Peden, suggests the desirability of ankle restraints to prevent the prisoner from kicking (col. 1, lines 26-30). Geisinger teaches that many such restraints may be carried on the person of a police officer (col. 2, lines 52-56), but Geisinger does not suggest a need for more compact storage of his restraint. Therefore,

Geisinger fails to provide motivation to tightly coil his restraint in a manner similar to Peden.

In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modifications. *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). For the above reasons, one skilled in the art would not be led by either Peden or Geisinger to combine their respective teachings to produce the claimed invention. Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of claim 17.

VI. Claims 1-8, 18 and 21-24 are Not Obvious over Peden in view of Arthur and Geisinger

At page 4, paragraph 4 of the instant Office Action, claims 1-8, 18 and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,469,813 to Peden in view of US 1,797,539 to Arthur and US 5,193,254 to Geisinger. The Examiner is of the opinion that it is obvious to combine the tightly coiled ankle restraint of Peden with elastic band of Arthur and the toothed, single slotted strap wrist or ankle restraint of Geisinger in order to arrive at the claimed invention. Applicant respectfully traverses the rejection.

For the same reasons as submitted above in section V, Peden and Geisinger fail to provide motivation to combine their respective teachings. Peden in no way suggests the need to secure the disclosed coiled restraint to prevent it from unwinding. Peden is silent on, and does not seem to be aware of an unwinding problem. Therefore, Peden fails to provide motivation to secure his coiled restraint with an elastic band as taught by Arthur. Furthermore, Arthur is non-analogous art for reasons submitted above in section IV.

Arthur in no way suggests that his disclosed elastic retainer may be used to prevent the unwinding of anything other than photographic film, and certainly not police restraints.

For the above reasons, one skilled in the art would not be led by either Peden or Geisinger or Arthur to combine their respective teachings to produce the claimed invention. As a *prima facie* case of obviousness has not been established, Applicant respectfully requests withdrawal of the rejection and allowance of independent claim 1 with dependent claims 2-8, independent claim 18, and independent claim 21 with dependent claims 22-24.

VII. Claims 25-28 are Not Obvious over Bingold in view of Arthur and Peden

At page 6, paragraph 2 of the instant Office Action, claims 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,159,728 to Bingold in view of US 1,797,539 to Arthur and US 5,469,813 to Peden. The Examiner is of the opinion that it would be obvious to combine the two-strap restraint of Bingold with the elastic band of Arthur and the tightly coiled restraint of Peden to arrive at the claimed invention. Applicant respectfully traverses the rejection.

For the same reasons as submitted above in section IV, Bingold and Arthur fail to provide motivation to combine their respective teachings. The Examiner asserts that it would be obvious in view of Peden's teaching of a greater number of tightly coiled loops to modify the four-loop restraint configuration of Bingold to have at least three loops to each strap. However, the design of Bingold's restraint prevents coiling the straps into more than two loops, because apertures 51 and 52 are sized so as to only allow the passage of one strap 14 or 16 plus a narrowed tip portion 29 or 30 (col. 9, lines 40-51). Therefore, it is not possible to combine Peden and Bingold as the Examiner suggests. Even if it were possible, Bingold teaches that the four-loop configuration is compact, and

does not recognize the need to make his restraint more compact by increasing the number of loops. Peden does not provide motivation to combine teachings with Bingold because more tightly coiling the two-strap restraint of Bingold as the Examiner suggests would not provide an ankle restraint that is also able to attach to manacles on a prisoner's wrists. The suggested combination is inoperable for the purposes of Peden.

For the above reasons, one skilled in the art would not be led by either Bingold or Arthur or Peden to combine their respective teachings to produce the claimed invention. As a *prima facie* case of obviousness has not been established, Applicant respectfully requests withdrawal of the rejection and allowance of independent claim 25 with dependent claims 26-28.

VIII. Conclusion

Having addressed all outstanding issues, Applicant respectfully requests reconsideration and allowance of this application.

FEE AUTHORIZATION

Should any fees be due in connection with this submission, please charge the same to our Deposit Account No. 19-0733.

Respectfully submitted,

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